



# A.F/2859  
IFW

Attorney Docket No.: 225/49355  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

AXEL SCHAMAL

Group Art Unit: 2859

Serial No.: 09/674,852

Examiner: T. Reis

Filed: December 14, 2000

For: DEVICE FOR DETERMINING THE POSITION OR SIZE OF A HOLE

APPEAL BRIEF

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Real Party in Interest

The real party in interest is DaimlerChrysler AG, Epplestrasse 225, 70567 Stuttgart, Germany, by virtue of an assignment recorded in the U.S. Patent and Trademark Office assignment records at reel 011385, frame 0165.

Related Appeals and Interferences

No interferences or other appeals which would affect, be affected by, or have a bearing on a decision in this appeal are known.

07/14/2004 HALI11 00000056 09674852

01 FC:1402

330.00 OP

CH

### Status of Claims

Claims 1, 3-6, and 8-10 are pending in this application, are rejected, and are now appealed. Claims 2 and 7 were cancelled by way of the reply filed October 16, 2002. An appendix containing a copy of claims 1, 3-6, and 8-10 is attached to this Appeal Brief.

### Status of Amendments

No amendment has been filed subsequent to the final rejection set forth in the Office Action dated February 10, 2004.

### Summary of Invention

A concise explanation of the invention will now be provided. This explanation refers, by way of example only and without intending to limit the claims, to certain drawing figures and to page and line numbers of the substitute specification filed November 7, 2000.

A device for determining the position of or for measuring a hole in a body part of a motor vehicle (see, for example, page 2, lines 13-16) includes a spike 1 for fitting into the hole (see, for example, page 4, lines 30-32) and an attachment element 2 having an essentially hemispherical or partially spherical shell 3 and an insert 4 arranged within the shell (see, for example, page 4, lines 7-12 and 38-40, and Figures 2-3). By way of a screw thread 1a (see, for example, page 4, lines 7-8), the attachment element 2 is releasably connectable to the spike 1 and, with the spike

fitted into the hole, rests on the component surface surrounding the hole (see, for example, Figure 3).

As discussed, for example, in lines 20-26 on page 4, the shell 3 may be made of a non-magnetic material, and the insert 4 arranged within the shell may be made of magnetic material. Referring to Figures 2 and 3, as noted in lines 14-16 on page 4, a lower edge 3a of the shell bears substantially flush against a lower side 4a of the insert when the device is assembled. According to certain configurations of the device, the spike 1 can be fastened to the attachment element 2 in an asymmetrical manner with respect thereto (see, for example, page 3, lines 21-24).

## Issues

The following issues are presented for review.

1. Whether claims 1, 3, 4, and 6 are unpatentable over U.S. Patent 2,419,134 to Hall in view of U.S. Patent 4,680,869 to Murkens.
2. Whether claims 5 and 8-10 are unpatentable over the Hall and Murkens patents in view of U.S. Patent 4,220,187 to Holmes.

## Grouping of Claims

With respect to issue 1 above, claims 1, 3, 4, and 6 stand or fall together.

With respect to issue 2 above, claims 5 and 8-10 stand or fall together.

## Argument

I. The rejection of claims 1, 3, 4, and 6 as being unpatentable over the Hall and Murkens patents is erroneous.

In section 2 on pages 2-3 of the Office Action, the Examiner proposes to “add” the magnetic second hollow cylindrical member 32 disclosed by Murkens to the ball like portion 1 forming part of the Hall locator, in part because the ball like portion 1 “can stably locate holes in vertical surfaces”. The Hall patent, however, already discloses various ways in which the ball like portion may be stably located or clamped solidly in place. Lines 16-19 in column 2 of the Hall patent, for example, provide that there is a recess 6 by which the device may be held by a clamp. The Hall patent further contemplates using a threaded element (see column 2, lines 21-24), a screw and washer (see column 3, lines 68-70 and column 4, lines 6-10), and a strap (see column 4, lines 11-21) to secure the ball like portion in place. The addition proposed by the Examiner, therefore, duplicates an already existing function and is unnecessary.

The Examiner’s proposal to arbitrarily add the second hollow cylindrical member 32 of the Murkens permanent magnet assembly 33 to the ball like portion 1 of the Hall locator is inappropriate. Lines 32-40 in column 2 of the Murkens patent provide that the Murkens permanent magnet assembly 33 includes a first hollow cylindrical member 31 and a permanent central magnet 34 as well as the second hollow cylindrical member 32 referred to by the Examiner. Nothing properly relied on by the Examiner suggests separating member 32 from member 31 and magnet

34 and adding only that member 32, in the manner proposed, to the ball like portion 1 of the Hall locator.

The proposed addition of the magnetic second hollow cylindrical member 32 disclosed by Murkens is further justified by the Examiner because “the stably locating means claimed by Applicant and the stably locating means used by Hall & Murkens are well known alternate types of stably locating means ....” As noted in MPEP §2144.03(A), however, official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well known are capable of instant and unquestionable demonstration. No claim of the present application recites “stably locating means,” and it is unclear which elements of either the claimed invention or the Hall locator, as the Examiner proposes to modify it, the Examiner considers to be the “stably locating means” referred to in the rejection. It certainly is questionable, therefore, as to whether any “stably locating means” of the present invention is a well known alternate to any other “stably locating means” as the Examiner asserts, and the official notice taken by the Examiner is improper.

The modification to the locator forming the subject matter of the Hall patent proposed by the Examiner in section 2 on pages 2-3 of the Office Action is inappropriate for reasons discussed above, and the Hall and Murkens patents, taken as a whole, do not suggest the subject matter of any of claims 1, 3, 4, and 6. The rejection of these claims, which relies on the modification proposed by the Examiner, is erroneous and should be reversed.

II. The rejection of claims 5 and 8-10 as being unpatentable over the Hall, Murkens, and Holmes patents is also erroneous. This rejection relies on the same proposed modification to the Hall locator discussed in section I above and should be reversed for the same reasons.

Respectfully submitted,

Richard R. Diefendorff  
Reg. No. 32,390

CROWELL & MORING LLP  
P.O. Box 14300  
Washington, D.C. 20044-4300  
Telephone No.: (202) 624-2500  
Facsimile No.: (202) 628-8844  
RRD:msy



## Appendix

1. Device for determining the position of or for measuring a hole in a body part of a motor vehicle, comprising:

a spike for fitting into the hole, and

an attachment element which is releasably connectable to the spike and, with the spike fitted into the hole, rests on the component surface surrounding the hole,

wherein the attachment element has an essentially hemispherical or partially spherical shell made of a non-magnetic material and an insert arranged within the shell and made of magnetic material, and

wherein a lower edge of the shell bears substantially flush against a lower side of the insert.

3. Device according to Claim 1, wherein the attachment element is releasably connectable to the spike by a screw thread.

4. Device according to Claim 3, wherein the spike has an upper part with the screw thread which is adapted to pass through the insert and be screwed to the inside of the shell.

5. Device for determining the position of or for measuring a hole in a component comprising:

a spike for fitting into the hole, and

an attachment element which is releasably connectable to the spike and, with the spike fitted into the hole, rests on the component surface surrounding the hole,

wherein at least part of the attachment element is produced from a magnetic material, and

wherein the spike is adapted to be fastened to the attachment element in an asymmetrical manner with respect thereto.

6. Attachment element for a device for determining the position of or for measuring a hole which is releasably connectable to a spike which is adapted to fit into the hole, at least part of the attachment element being produced from a magnetic material, comprising an essentially hemispherical or partially spherical shell made of a non-magnetic material and an insert arranged within the shell and made of a magnetic material, wherein a lower edge of the shell bears substantially flush against a lower side of the insert.

8. Device for determining the position of or for measuring a hole in a component comprising:

a spike for fitting into the hole, and

an attachment element which is releasably connectable to the spike and, with the spike fitted into the hole, rests on the component surface surrounding the hole,

wherein the attachment element has an essentially hemispherical or partially spherical shell made of a non-magnetic material and an insert arranged within the shell and made of magnetic material, and

wherein the spike is adapted to be fastened to the attachment element in an asymmetrical manner with respect thereto.

9. Device for determining the position of or for measuring a hole in a component comprising:

a spike for fitting into the hole, and

an attachment element which is releasably connectable to the spike and, with the spike fitted into the hole, rests on the component surface surrounding the hole,

wherein the attachment element has an essentially hemispherical or partially spherical shell made of a non-magnetic material and an insert arranged within the shell and made of magnetic material,

wherein the attachment element is releasably connectable to the spike by a screw thread, and

wherein the spike is adapted to be fastened to the attachment element in an asymmetrical manner with respect thereto.

10. Device for determining the position of or for measuring a hole in a component comprising:

a spike for fitting into the hole, and

an attachment element which is releasably connectable to the spike and, with the spike fitted into the hole, rests on the component surface surrounding the hole,

wherein the attachment element has an essentially hemispherical or partially spherical shell made of a non-magnetic material and an insert arranged within the shell and made of magnetic material,

wherein the attachment element is releasably connectable to the spike by a screw thread,

wherein the spike has an upper part with the screw thread which is adapted to pass through the insert and be screwed to the inside of the shell, and

wherein the spike is adapted to be fastened to the attachment element in an asymmetrical manner with respect thereto.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

JUL 09 2004  
PATENT & TRADEMARK OFFICE  
U.S. DEPARTMENT OF COMMERCE  
STC113

# FEET TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$ 330)

<i>Complete if Known</i>	
Application Number	09/674,852
Filing Date	December 14, 2000
Inventor	Axel SCHAMAL
Examiner Name	T. Reis
Art Unit	2859
Attorney Docket No.	225/49355

## METHOD OF PAYMENT (check all that apply)

 Check     Credit Card     Money Order     Other     None
 Deposit Account:

Deposit Account Number	05-1323
Deposit Account Name	Crowell & Moring LLP

The Director is authorized to: (check all that apply)

 Charge fee(s) indicated below     Charge any deficiency or credit any overpayments to the deposit account of the undersigned. Attorney Docket No. 038738.49355

 Charge any additional fee(s) during the pendency of this application.

 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity Fee	Small Entity Fee	Fee Description	Fee Paid
Code (\$)	Code (\$)		
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1) \$ 

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Fee from below		Fee Paid
	Extra Claims	Fee from below	
-20** =	x	=	
-3** =	x	=	
Multiple Dependent		=	

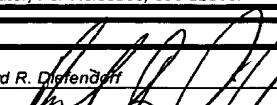
  

Large Entity Fee	Small Entity Fee	Fee Description	Fee Paid
Code (\$)	Code (\$)		
1202 18	2202 9	Claims in excess of 20	
1201 86	2201 43	Independent claims in excess of 3	
1203 290	2203 145	Multiple dependent claim, if not paid	
1204 86	2204 43	** Reissue independent claims over original patent	
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) \$ 

\*or number previously paid, if greater; For Reissues, see above.

FEE CALCULATION (continued)		
3. ADDITIONAL FEES		
Large Entity	Small Entity	
Fee Code (\$)	Fee Code (\$)	
1051 130	2051 65	
1052 50	2052 25	Surcharge – late filing fee or oath
1053 130	1053 130	Surcharge – late provisional filing fee or cover sheet
1812 2,520	1812 2,520	Non-English specification
1804 920*	1804 920*	For filing a request for ex parte reexamination
1805 1,840	1805 1,840	Requesting publication of SIR prior to Examiner action
1251 110	2251 55	Requesting publication of SIR after Examiner action
1252 420	2252 210	Extension for reply within first month
1253 950	2253 475	Extension for reply within second month
1254 1,480	2254 740	Extension for reply within third month
1255 2,010	2255 1,005	Extension for reply within fourth month
1401 330	2401 165	Extension for reply within fifth month
1402 330	2402 165	Notice of Appeal
1403 290	2403 145	Filing a brief in support of an appeal
1451 1,510	1451 1,510	Request for oral hearing
1452 110	2452 55	Petition to institute a public use proceeding
1453 1,330	2453 665	Petition to revive – unavoidable
1501 1,330	2501 665	Petition to revive – unintentional
1502 480	2502 240	Utility issue fee (or reissue)
1503 640	2503 320	Design issue fee
1406 130	1460 130	Plant issue fee
1807 50	1807 50	Petitions to the Commissioner
1806 180	1806 180	Processing fee under 37 CFR 1.17(q)
8021 40	8021 40	Submission of Information Disclosure Stmt
1809 770	2809 385	Recording each patent assignment per property (times number of properties)
1810 770	2810 385	Filing a submission after final rejection (37 CFR § 1.129(a))
1801 770	2801 385	For each additional invention to be examined (37 CFR § 1.129(b))
1802 900	1802 900	Request for Continued Examination (RCE)
		Request for expedited examination of a design application
Other fee (specify) _____		
*Reduced by Basic Filing Fee Paid		
SUBTOTAL (3) (\$ 330)		

SUBMITTED BY		Complete (if applicable)	
Name (Print/Type)	Richard R. Diefendorff	Registration No. (Attorney/Agent)	32,390
Signature		Telephone	202-624-2500
		Date	July 9, 2004

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.